

**Notice of Allowability**

Application No.

10/797,185

Examiner

Taylor Victor Oh

Applicant(s)

NOSE ET AL.

Art Unit

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/24/04.
2. ☒ The allowed claim(s) is/are 1-6.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 5/04 & 3/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 3/3/05
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_



Examiner's Amendment and Reasons of Allowance

The Status of Claims

Claims 1-6 are pending.

Claims 1-6 have been allowed.

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Richard Gallagher on 3/3/05.

I. The application has been amended as follows:

In claim 1 on page 23:

The term "--derivative--" after the term "An acid halide" has been deleted.

In claim 2 on page 23:

The term “ --derivative--” after the term “The acid halide” has been deleted.

In claim 3 on page 23:

The term “ --derivative--” after the term “an acid halide” has been deleted.

The term “ --derivative--” after the term “a benzyl halide” has been deleted.

In claim 3 on page 24:

The term “ --derivative--” after the phrase “to yield a malonic diester” has been deleted.

The term “ --derivative--” after the phrase “hydrolyzing the malonic diester” has been deleted.

The term “ --derivative--” after the phrase “ to yield a malonic monoester ” has been deleted.

In claim 3 on page 25:

The term “ --derivative--” after the phrase “ allowing the malonic monoester ” has been deleted.

The term “ --derivative--” after the term “the acid halide” has been deleted.

In claim 4 on page 23:

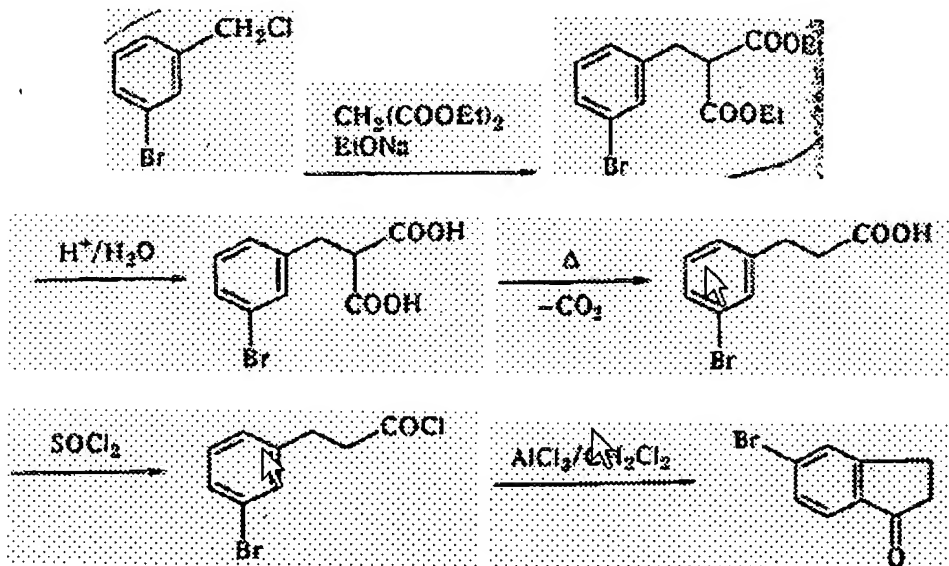
The term “--derivative--” after the phrase “cyclizing an acid halide” has been deleted.

The term “-- a catalyst--” after the phrase “in the presence of” has been replaced with “ a Lewis acid catalyst”.

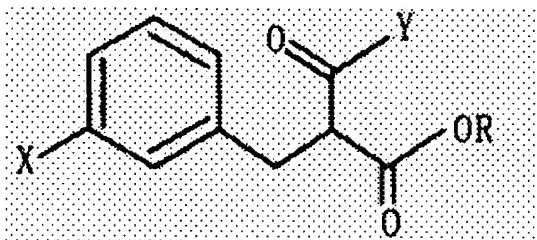
III. The following is an examiner's statement of reasons for allowance:

- The close reference for the current invention is Matveeva et al (Russian Journal of Organic Chemistry vol. 38, no. 12, p. 1769-1774).

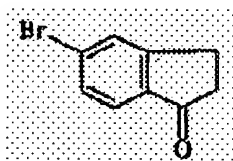
Matveeva et al discloses a process of producing an indanonecarboxylic acid ester in the following scheme of the reaction process below:



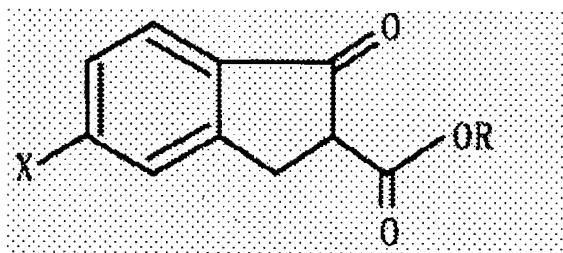
The instant invention, however, differs from the prior art in that the claimed starting



compound, wherein R is a lower alkyl specified in the specification (page 7, lines 10-21) and X and Y are a halogen atom is not disclosed; there is no intermediate step of producing a malonic monoester derivative; therefore, the desired final



product of the prior art is different from the claimed final product



Also, there is no motivation in the prior art to arrive at the current invention .

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to "Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Wang, J. Sh*  
*3/3/55*

*Cecilia J. Tsang*  
Cecilia J. Tsang  
Supervisory Patent Examiner  
Technology Center 1600